

U.S. Pat. Appl. Ser. No. 09/755,866
Att. Docket No. 10191/1657
Reply to Office Action of June 25, 2004

REMARKS

Claims 11 to 26 are added, and therefore claims 1 to 26 are now pending.

It is respectfully requested that the Examiner acknowledge whether the priority documents have been received (since it is unclear from the present Office Action) in the next Office communication.

Applicants thank the Examiner for acknowledging acceptance of the drawings.

On page two (2) of the Office Action, claim 10 was objected to since it used the term "arrangement". While the objection may not be agreed with, to facilitate matters, claim 10 has been rewritten using the "means" language. It is therefore respectfully requested that the objection be withdrawn.

With respect to page eight (8) of the Office Action, claims 4, 5, 7 and 9 were objected to, since it was indicated that they contained allowable subject matter. While the rejections may not be agreed with, as explained below, to facilitate matters, claims 4 (claim 5 depends from claim 4), 7 and 9 have been rewritten as independent claims. It is therefore respectfully requested that the objections be withdrawn since claims 4, 5, 7 and 9 are allowable.

With respect to page two (2) of the Office Action, claims 1 to 3, 6, 8 and 10 were rejected under 35 U.S.C. § 103(a) as obvious over "Ying", U.S. Patent No. 6,061,600 in view of "Paratore", U.S. Patent No. 5,666,358.

To reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the "problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem", Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998). It is respectfully submitted that the references applied do not address the problem addressed by the presently claimed subject matter, as referred to in the specification of the present application.

Also, to reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria

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must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 1 is to a method for an exchange of data in messages between at least two users connected by a bus system, each one of the at least two users including at least one of a predefinable timing mark and an ascertainable timing mark, which includes: causing the at least two users to transmit via the bus system messages including the data; *causing a first one of the at least two users, in a function as timer, to control the messages as a function of time such that the first one of the at least two users repeatedly transmits a first reference message including a first time information regarding a time base of the first one of the at least two users, via the bus system at a specifiable time interval; and if the at least one of the predefinable timing mark and the ascertainable timing mark of a second one of the at least two users is reached without the first reference message of the first one of the at least two users reaching the second one of the at least two users, causing the second one of the at least two users to take over the function of timer by transmitting a second reference message with a second time information via the bus system.*

The Office Action admits that the primary "Ying" reference does not disclose the feature of *causing a first one of the at least two users, in a function as timer, to control the messages as a function of time such that the first one of the at least two users repeatedly transmits a first reference message including a first time information regarding a time base of the first one of the at least two users, via the bus system at a specifiable time interval*. The Office Action then asserts that this is provided by the secondary "Paratore" reference.

It is respectfully submitted, however, that this assertion makes plain (as does any review of the cited text of the references) that the primary reference also does not disclose the claim 1 feature of *causing the second one of the at least two users to take over the function of timer by transmitting a second reference message with a second time*

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information via the bus system if the at least one of the predefinable timing mark and the ascertainable timing mark of a second one of the at least two users is reached without the first reference message of the first one of the at least two users reaching the second one of the at least two users. This is plain for the simple reason that the primary reference cannot disclose something which necessarily depends on and requires the first “causing” feature. Accordingly, claim 1 is allowable.

Claims 2, 3, 6, and 8 depend from claim 1, and are therefore allowable for the same reasons as claim 1, which is allowable for the reasons explained above.

Claim 10 includes features like those of claim 1, except that claim 10 includes “means-plus-function” language, and is therefore allowable for essentially the same reasons as claim 1.

As further regards the obviousness rejections, the cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), also make plain that the Office Action’s assertions that it would have been obvious to modify the reference relied upon does not properly support a § 103 rejection. It is respectfully suggested that those cases make plain that the Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to

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**make the modifications . . . necessary to arrive at the
claimed [invention].**

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

That is exactly the case here since it is respectfully submitted that the Office Action reflects hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” -- which is not even the case here, there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed”, stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. *With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed.* In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

(See In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Federal Circuit 2000) (italics added)). Here again, there have been no findings that establish that the features discussed above of the rejected claims are met by the references relied upon. As referred to above, any review of the references, whether taken alone or combined, makes plain that they simply do not describe the features discussed above of the rejected claims.

Thus, the proper evidence of obviousness must show why there is a suggestion to modify the reference so as to provide the subject matter of the claims and its benefits.

It is therefore respectfully requested that the obviousness rejection be withdrawn in view of the foregoing.

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New claims 11 to 26 do not add any new matter and are supported in the specification.

New claims 11 to 14 depend from allowable claim 10, and are therefore allowable for the same reasons as allowable claim 10. New claims 11 to 14 respectively include features like those of claims 2, 3, 8 and 6, except that they depend from claim 10.

New claims 15, 16 and 17 correspond to allowable claims 4, 5 and 9, except that claims 15, 16 and 17 include "means-plus-function" language, and are therefore allowable for the same reasons as claims 4, 5 and 9.

New claim 18 corresponds to allowable claim 7, except that it includes "means-plus-function" language, and is therefore allowable for the same reasons as claim 7.

New claims 19 to 22 depend from allowable claim 4, and are therefore allowable for the same reasons as allowable claim 4. New claims 19 to 22 respectively include features like those of claims 2, 3, 8 and 6, except that they depend from claim 4.

New claims 23 to 26 depend from allowable claim 7, and are therefore allowable for the same reasons as allowable claim 7. New claims 23 to 26 respectively include features like those of claims 2, 3, 8 and 6, except that they depend from claim 7.

It is therefore respectfully submitted that all of claims 1 to 26 are allowable.

CONCLUSION

In view of the foregoing, it is believed that the objections and rejections have been obviated, and that claims 1 to 26 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, and that the present application issue as early as possible.

Respectfully submitted,
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